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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,433

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Rainer Orben

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EXAMINER

COOLEY, CHARLES E

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

06/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,433	Applicant(s) ORBEN ET AL.	
	Examiner Charles E. Cooley	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20060609; 20070312; 20070821</u> . | 6) <input type="checkbox"/> Other: _____ |

NON-FINAL OFFICE ACTION

- 1. This application has been assigned to Technology Center 1700, Art Unit 1797 and the following will apply for this application:**

Please direct all written correspondence with the correct application serial number for this application to **Art Unit 1797**.

Telephone inquiries regarding this application should be directed to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 or to the Examiner at (571) 272-1139. All official facsimiles should be transmitted to the centralized fax receiving number 571-273-8300.

Priority

2. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All of the CERTIFIED copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The disclosure is objected to because of the following informalities:
- a. the many references to the features of particular claims throughout the specification are improper (e.g., see ¶ [0001] and [0006]) because the specification

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should positively recite the features of the claims rather than inferentially referring to subject matter of a particular claim through incorporation by reference thereto.

b. The specification should have the following headings inserted therein at the appropriate locations in accordance with 37 CFR 1.77:

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

- (a) Title of the Invention.
- (b) Cross-References to Related Applications (if any).
- (c) Statement as to rights to inventions made under Federally-sponsored research and development (if any).
- (d) Background of the invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 C.F.R. §§ 1.97-1.99.
- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).
- (l) Abstract of the Disclosure.

Appropriate correction is required.

5. The Abstract of the Disclosure is objected to because:

a. the inclusion of legal phraseology such as "means" and "said" in the abstract is improper.

Correction is required. See MPEP § 608.01(b).

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed (MPEP 606.01).

Claim Objections

7. Claim 9 is objected to because element 15 is described in the specification as a “filling head 15”, not a mixing head as recited in the claim.

Correction is required.

Claim Rejections - 35 USC § 103

8. The terms used in this respect are given their broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art, in light of the written description in the specification, including the drawings, without reading into the claim any disclosed limitation or particular embodiment. See, e.g., *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). The Examiner interprets claims as broadly as reasonable in view of the specification, but does not read limitations from the specification into a claim. *Elekta Instr. S.A.v.O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000).

9. To determine whether subject matter would have been obvious, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the

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circumstances surrounding the origin of the subject matter sought to be patented."

Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966).

The Supreme Court has noted:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-41 (2007). "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." (Id. at 1742).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 9, 10, 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClain et al. (US 7,065,429 B1) in view of WO 02/083282 A1.

The patent to McClain et al. discloses a metering system 10 for preparing an emulsion paint from two or more aqueous paint components in the desired composition, having a mixing vessel 20 and a container 12-18 for each paint component, each container being connected via a conveying line (Fig. 1) to a filling head 96 in the feed region of the mixing vessel (Fig. 2), each conveying line having a metering valve 50-56 in the feed region, and the metering valves being connected to a control apparatus 80 in order to control the metering of the paint components in accordance with the desired composition, and in each conveying line a conveying pump 30-36 is provided; the conveying lines are connected to the lower region of the respective containers 12-18 as seen in Fig. 1; a balance 70 for weighing the mixing vessel 20; the system used for preparing and dispensing aqueous emulsion paints to end customers (col. 1, lines 56-59). McClain et al does not disclose the containers for the aqueous paint components are formed by watertight bags having a capacity of 200 L to 1500 L ; a printer for a label to be applied to the mixing vessel and the printer prints the data for settlement at the till on the label.

WO 02/083282 A1 discloses a discloses a metering system 20 for preparing an substance from two or more components in the desired composition, having a mixing vessel 50 and a container 12 for each component, each container being connected via

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a conveying line (Fig. 1); a control apparatus 44; in each conveying line a conveying pump 22 is provided; the conveying lines are connected to the lower region of the respective containers 12 as seen in Figs. 2-5; the containers 12 being watertight bags; a printer 70 for a label 72 to be applied to the mixing vessel 50 and the printer prints the data for settlement at the till on the label (p. 11, first full paragraph and p. 23, first full paragraph). Since McClain et al. explicitly suggests that the containers 12-18 "may be any of several other containers that are suitable for holding aqueous compositions" (col. 6, lines 57-59), it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have substituted the containers of McClain et al. with bags as taught by WO '282 for the purposes of providing an oxygen-protected environment for the components that are within the sealed bags (p. 4, last paragraph and p. 7, last paragraph) and to have provided McClain et al. with a printer for a label to be applied to the mixing vessel and the printer prints the data for settlement at the till on the label as taught by WO '282 for the purposes of identifying the containers of the mixing vessel, to provide instructions, pertinent indicia, or a bar code for the vessel (p. 11, first full paragraph).

With regard to the recited capacity of the bags, the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ

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232 (1984). Since the capacity of the bags is an obvious choice of design adapted to the intended use of the system (e.g., tailored to production requirements, duty cycles, space constraints, etc.), to have provided McClain et al. with bags with the recited capacity would have been wholly obvious to one skilled in the art, if not mere common sense. The examiner does not and will not consider the size of the bags to be a novel or unobvious feature that defines over the prior art.

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over McClain et al. (US 7,065,429 B1) in view of WO 02/083282 A1 as applied to claim 10 above and further in view of Cane (US 5,493,840).

McClain et al. (US 7,065,429 B1) in view of WO 02/083282 A1 do not disclose the shaker. Cane discloses an analogous automated dispensing and mixing apparatus for applying tints to a vessel 20 of base paint that comprises a framework 10 on which the apparatus is mounted; a shaker 24 on the framework for shaking the vessel of base paint; means 33, 34, 36 are positioned on the framework for dispensing tint colors into said base paint in the vessel 20 thereof, computer means 17 including a touch apparatus for applying coloration tint to a base paint; a label applying apparatus 54, a reservoir 33 for each of said tint colors; and a valve 33 adjacent each said reservoir controlled by said computer means for precisely determining any flow of tint therethrough. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided McClain et al. (US 7,065,429 B1) in view of WO 02/083282 A1 with a shaker as taught by Cane for the purposes of

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mixing the contents of the vessel to provide a homogenous mixture to the end user (col. 10, lines 1-13).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley in Art Unit 1797 whose telephone number is (571) 272-1139. The examiner can normally be reached on Monday - Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Additional assistance can be obtained via the Ombudsman Pilot Program is designed to enhance the USPTO's ability to assist applicants and/or their representatives with issues that arise during patent application prosecution. More specifically, if there is a breakdown in the normal prosecution process, the Ombudsman Pilot Program can assist in getting the process back on track. See <http://www.uspto.gov/patents/ombudsman.jsp> . If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles E. Cooley/

Charles E. Cooley
Primary Examiner
Art Unit 1797

22 June 2010